

REMARKS

Claims 1-4, 8, 9, 11-19, 23, 24, 26-30, and 39-49 were pending in this application.

Claims 1-4, 8, 9, 11-19, 23, 24, 26-30, and 39-49 have been rejected.

Claims 1 and 16 have been amended as shown above.

Claims 1-4, 8, 9, 11-19, 23, 24, 26-30, and 39-49 remain pending in this application.

Reconsideration and full allowance of Claims 1-4, 8, 9, 11-19, 23, 24, 26-30, and 39-49 are respectfully requested.

I. OBJECTIONS TO CLAIMS

The Office Action objects to an informality in Claims 1 and 16. The Applicant has amended Claims 1 and 16 to correct the noted informality. Accordingly, the Applicant respectfully requests withdrawal of the objections to the claims.

II. REJECTIONS UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-4, 8, 9, 11-19, 23, 24, 26-30, and 39-49 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,422,464 to Terranova ("*Terranova*"). The Office Action rejects Claims 1-4, 8, 9, 11-19, 23, 24, 26-30, and 39-49 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,820,062 to Gupta et al. ("*Gupta*"). These rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they

are in the claims. (*MPEP § 2131; In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (*Fed. Cir.* 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. (*MPEP § 2131; In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (*Fed. Cir.* 1985)).

First, the Office Action improperly ignores claim limitations while rejecting the claims. For example, Claim 1 recites “transmitting customer profile information ... from a central location to [a] select commercial transaction location,” where the element of transmitting includes “converting the customer profile information into a profile data word” and “transmitting the profile data word to the select commercial transaction location.” Claim 1 also recites “decoding, at the select commercial transaction location, the profile data word to define decoded profile information.”

The Applicant respectfully submits that the Office Action fails to show that *Terranova* or *Gupta* anticipates these elements of Claim 1. In particular, the Office Action does not show that *Terranova* and *Gupta* “convert” customer profile information into a “profile data word” for transmission and then “decode” the profile data word to define “decoded profile information” at a “select commercial transaction location.” The Applicant has reviewed the Office Action’s lengthy description (ten pages) of *Terranova* and *Gupta* and simply cannot find any support for the anticipation rejection of these claim elements.

Instead, the Office Action makes the following statement:

The latter limitations represent a typical and well understood jargon used by those skilled in the field of computer programming, and these limitations are interpreted as --receiving preference or profile data from an identified customer at a central location for analysis, storage and later retrieval and forwarding the profile or preference data from

the central location to the commercial location, which uses the forwarded profile data to present a customized programming to the identified customer via a display coupled to the fuel dispenser.

(Office Action, Page 21, First paragraph).

This interpretation of the claims is improper. This interpretation fails to take into consideration the claim language, including “converting” or “decoding” (or anything similar). In other words, the Office Action appears to erroneously assert that these claim elements are anticipated even if no conversion of profile information into a profile data word or decoding of a profile data word is described.

Though the Patent Office is free to reasonably interpret the claims as broadly as possible, the Patent Office cannot ignore express recitations in the claims. Claim 1 clearly recites “converting the customer profile information into a profile data word” and “decoding ... the profile data word to define decoded profile information.” The Patent Office is required to show that *Terranova* and *Gupta* expressly or inherently disclose these elements of Claim 1. If the Patent Office cannot make this showing, the Patent Office must withdraw the anticipating rejections.

Notwithstanding the deficiencies noted above, the Applicant respectfully requests that the Patent Office provide proof that “those skilled in the field of computer programming” would interpret the phrases “converting the customer profile information into a profile data word” and “decoding ... the profile data word to define decoded profile information” as including “receiving preference or profile data ... for analysis, storage and later retrieval and forwarding the profile or preference data from the central location to the commercial location.” The Applicant respectfully submits that the Patent Office cannot make this showing. A person skilled in the art would not

interpret the phrase “converting the customer profile information into a profile data word” as including “receiving preference or profile data ... for analysis, storage and later retrieval” without some form of conversion into a “profile data word.” Similarly, a person skilled in the art would not interpret the phrase “decoding ... the profile data word to define decoded profile information” as including “forwarding the profile or preference data from the central location to the commercial location” without some form of decoding of the “profile data word.”

Claim 1 clearly and unambiguously recites “converting the customer profile information into a profile data word” and “decoding ... the profile data word to define decoded profile information.” These claim elements cannot be anticipated by simply showing that *Terranova* and *Gupta* receive, store, and retrieve profile data. None of this requires “converting” customer profile information into a “profile data word” or “decoding” the “profile data word” to define “decoded profile information” as recited in Claim 1. As a result, both *Terranova* and *Gupta* fail to anticipate these elements of Claim 1.

Second, Claim 1 recites that “update information” and “advertising information” are merged “in accordance with the decoded profile information,” where the “update information” and “advertising information” are “previously transmitted to the select commercial transaction location from the central location and stored at the select commercial transaction location prior to the commercial transaction.”

Among other things, the Office Action notes that *Terranova* stores customer preferences in transponders or in local databases. However, the storage of customer preferences is not relevant with respect to the storage of “update information” and “advertising information.” In order to maintain

the rejections, the Patent Office is required to show that “update information” and “advertising information” are “previously transmitted to [a] select commercial transaction location from [a] central location” and “stored at the select commercial transaction location prior to [a] commercial transaction.” The Patent Office is also required to show that the “update information” and “advertising information” are merged “in accordance with the decoded profile information.” The Patent Office has failed to establish that *Terranova* anticipates these elements of Claim 1.

In *Terranova*, information to be displayed to a customer comes from a “central provider,” a local “dedicated auxiliary audio/video source” (such as a laser disc or DVD player), or “other data networks or systems.” (*Col. 37, Lines 42-52; Col. 39, Lines 12-20; Col. 40, Lines 22-24*). Information from a “central provider” or from “other data networks or systems” is retrieved only when it is needed and is not “stored at [a] select commercial transaction location prior to the commercial transaction.” Information from a local “dedicated auxiliary audio/video source” (such as a laser disc or DVD player) is not “previously transmitted to [a] select commercial transaction location from [a] central location.” As a result, *Terranova* fails to anticipate these elements of Claim 1.

In *Gupta*, information displayed to a customer may reside on a central computer 14. (*Col. 4, Lines 23-26*). For example, the information displayed to a customer could be stored on any electronic memory, be generated internally, or reside on video disks. (*Col. 10, Lines 63-67*). “New or changed products and/or prices” can also be entered into the central computer 14. (*Col. 4, Lines 26-32*). In other words, *Gupta* simply recites the storage of information that is later presented to customers. *Gupta* lacks any mention of using “decoded profile information” to “merge” both

“update information” and “advertising information.” As a result, *Gupta* fails to anticipate these elements of Claim 1.

For these reasons, the Office Action fails to establish that *Terranova* and *Gupta* anticipate all elements of Claim 1 (and its dependent claims). For some or all of the reasons given above, the Office Action also fails to establish that *Terranova* and *Gupta* anticipate all elements of Claims 16, 39, and 43 (and their dependent claims).

In the event the Patent Office maintains these claim rejections or issues new claim rejections, the Applicant respectfully requests that the Patent Office specifically identify where each cited reference discloses, teaches, or suggests each element of the claims.

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejections and full allowance of Claims 1-4, 8, 9, 11-19, 23, 24, and 26-30.

III. CONCLUSION

The Applicant respectfully submits that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

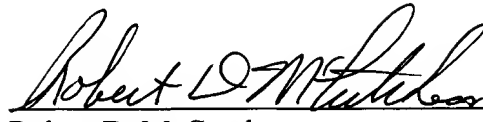
The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

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